REMARKS

The Office Action mailed July 23, 2003 has been carefully considered by the undersigned attorney on behalf of the inventors and their assignee. Amendments to this application have been presented in this paper in response to the Office Action and new claims have been proposed in response thereto.

Before the last Office Action, Applicants' attorney received a telephonic restriction requirement from the Examiner and elected claims with traverse in a Preliminary Amendment. The traverse has not been addressed in the present Office Action, that the claims were considered directed to a single invention and that a single search could cover most, if not all, of the claims originally presented. Further, the Office has not demonstrated that the various independent claims have achieved a separate status in the art.

In that Office Action, Claims 14 and 15 were rejected under 35 USC 102(a) based on a prior art patent to Liu and Claim 15 was rejected under 35 USC 102(e) based on a published patent application of Horowitz. Claims 14, 15, 22, 39 and 40 were rejected under 35 USC 103(a) based on a published patent application of Sears in view of the teachings of the Liu patent. Claims 16, 23 and 41 were rejected under 35 USC 103(a) based on a combination of the teachings of the Sears publication combined with the teachings of the Liu patent and the teachings of a published patent application of Gvily. Claims 17 and 42 were rejected under 35 USC 103(a) as being obvious in view of the combined teachings of the Sears publication, the Liu patent, the Gvily publication and a patent to Tominaga. Claims 18, 26, 43 and 44 were rejected under 35 USC 103(a) as being obvious based on the combination of the Sears publication, the Liu patent together with the teachings of a publication by Silverman. Claims 19, 27, 45 and 46 were rejected as obvious under 35 USC 103(a) based on the combination of the Sears

publication, the Liu patent and a publication by Scott. Claims 20, 24, 25, 47 and 48 were rejected as obvious under 35 USC 103(a) based on the combination of the Sears publication, the Liu patent and a patent to Salam. Claims 21 and 49 were rejected as obvious under 35 USC 103(a) based on the combination of the Sears publication, the Liu patent, the Salam patent and a publication by Huynh. Claim 22 was rejected based on the combination of the teachings of the Liu patent with a patent issued to Kamper.

In response to this Office Action, various claims have been amended to better define the scope of the present invention and new claims have been added which are believed to distinguish from the art cited.

The present invention, as described in the specification and illustrated in the accompanying drawings, is a novel method and system for creating a web page or the code for creating a web page with hotlinks from text using various tools to determine what hotlinks to include. These tools are claimed in various combinations and include a dictionary for determining common words which can be excluded from consideration, a list of past links which have been used (a "past links" list), a list of words for which no links could be determined (a "no links" list), and a user input to select a link. None of the references, alone or in combination, includes these features for a web page creation system or method or makes them obvious.

The art does show some of the features of the present invention, but does not suggest their combination. In fact, some of the features shown in the cited art (like the dictionary in the Gvily publication) are not even shown for the purpose which it is used in the present invention. Further, the individual references do not recite or suggest a motivation to combine the references, and those "motivations" which are mentioned in the Office Action are either not really suggested by material in the application or are specifically taught away from the

motivation suggested. Thus, in the Gvily publication, the idea is to use a proxy to process the data from a text page and process it, impliedly without involving the user. In fact, the Gvily reference recites that the data is stored hidden from the user's view but retrievable by the system, describing an automatic system that is free from user input. Thus, the combination of the Gvily publication with the Liu patent to provide a user input is contrary to the processing by the proxy in the Gvily reference. Further, the use in Gvily of a dictionary is not for the purpose of determining common words for which no web site is to be found, but for processing the DOM of an HTML Page (see col. 2, para [0028] of the Gvily reference) As a matter of fact, the modification of Sears and Liu is recited as "for the purpose of locating recognized words" whereas the applicants' invention uses the dictionary to determine words which are not recognized, either directly or in some variation. The motivation for combining references in some cases appears to be based on applicants' own teaching, which is a form of impermissible hindsight reconstruction (see the motivation for combining the Tominaga patent with Sears, Liu and Gvily "to include a dictionary augmented by rules for the purpose of efficient translation", which does not provide a reason for the dictionary or for the rules, except that it somehow would be efficient to do so.

Claim 14 as amended calls for a system for creating code for a web site in which the system includes a comparison to a dictionary for determining words in the text which are not found in the dictionary as well as for determining that a web site is associated with the word or phrase. It further requires a user input as to whether a site should be included and, if there is more than one web site, receiving a user designation as to which of the web sites to be associated with the word or phrase.

Claim 22 includes a program component which identifies a portion for which a dictionary entry does not exist and seeks to locate a web site for the portion where there is no dictionary entry.

Claim 39 describes a method of creating a web page which includes using a dictionary to determine words and phrases for which a dictionary entry does not exist and using the words and phrases for which no dictionary entry exists in the step of comparing words and phrases for which a web site is found.

All of the previously presented claims depend, either directly or indirectly from the independent claims discussed above and are believed patentable because the independent claims are urged to be patentable.

Newly presented claims either depend from one of the independent claims discussed above or are based on Claim 52, which calls for determining which links to consider based on comparing text with a dictionary, a "no links" list and a "prior links" list, as well as a user input, to determine which words and phrases should have a hotlink. None of the art cited includes reference to a dictionary, a "no links" list and a prior links list as well as a user input to determine whether the include a hotlink to the word or phrase in text under consideration.

The pending claims thus include limitations not seen or suggested in the references, alone or in combination, and are therefore believed patentable.

The pending claims, Claims 14- 28 and 39- 56, are therefore believed to be allowable over the art of record because the art simply does not teach the claimed inventions..

Applicants and their attorney want to get this patent application in condition for allowance at an early date, especially since the primary grounds of claim rejections are based on two prior art references, alone or in combination, which are substantially different from the

present invention. To assist the Examiner in getting this application in condition for allowance if any questions remain, a collect call to the undersigned is authorized at the Examiner's convenience if any questions or issues remain after consideration of the rationale which has been presented in this Amendment.

A Petition for Extension of Time and an authorization to charge my Visa account for the extension fee accompanies this paper. It is believed that no other fee is required for the filing of this paper, since the number of claims currently pending does not exceed the number of claims for which the fees have already been paid (38 total claims and 6 independent claims). However, if any additional fee is due in connection with the filing of this paper, including any patent application processing fees, the Patent Office is authorized to charge those fees to Deposit Account 50-0510 maintained in the name of International Business Machines Corporation (IBM), the assignee of the present application..

Respectfully submitted,
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EXHIBIT

(although this is not required by the current amendment practice, for the purpose of assisting the Examiner, here is a copy of the amended claims with markings showing insertions and deletions)

14. A system which creates at least part of the code for a web site comprising:

a parser which separates text into words and phrases;

a system which compares the words with a dictionary to identify words which do not appear in the dictionary and which compares the words and phrases with entries for which a web site is available and generates an output indicating one or more web site associated with one of the words and phrases;

a system which receives a user input indicating whether a web site should be associated with a word or phrase and which one or more of the web sites should be associated with the word and phrase; and

an editing system which generates a web site for the text which includes a hotlink for the web site(s) indicated by the user input.

16. A web site creation system of the type described in Claim 14 wherein the system which compares the words and phrases includes a dictionary, where the comparison includes variations of the words.

22. A stored program for creating at least part of the code for a web site based on a text, the stored program comprising:

a program component which identifies a portion of the text for which a web site may exist;

a program component which seeks to locate one or more web sites for the identified portions of text;

a program component which compares the portion of the text to a dictionary to determine that a dictionary entry for the portion does not exist;

a program component which seeks to locate one or more web sites for the identified portions of text where the dictionary entry of the portion does not exist;

a program component which responds to a user input to select whether to include a web site and, if more than one web site is identified, to select which web site or web sites will be included; and

a program component which creates a web site based on the text and includes a hot link to the one or more web sites which were selected by the user.

39. A method of creating a web page comprising the steps of

parsing text to separate it into words and phrases;

using a dictionary to determine words and phrases for which no dictionary entry is found;

comparing at least some of the words and phrases with entries for which a web site is available using the words and phrases for which no dictionary entry is found and generating an output indicating one or more web sites associates with at least one of the words and phrases;

receiving a user input which indicates whether a web site should be associated with a selected word or phrase and, if more than one web site has been identified, identifying which of the more than one web site should be associated with the selected word or phrase; and

editing the text to include a hotlink for the selected word or phrase based on the user input.

41. A method of creating a web page including the steps of Claim 39 wherein the step of [comparing includes the step of] using a dictionary includes the step of considering variations of words in the dictionary.